



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

7/17
2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,526	01/29/2001	Otto Dobrounig	ADI-020CN	9695
21323	7590	07/08/2004	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	19

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/771,526	DOBROUNIG, OTTO
	Examiner	Art Unit
	Steven Wong	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 November 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-12 and 24-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,3-12 and 24-27 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 09/126,876.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

Claims Rejections – 35 USC 112

Applicant's remarks filed November 14, 2003 have overcome the rejections under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-7 and 11 are rejected under 35 U.S.C. 102(3) as being anticipated by Aoyama. Note the rejections set forth in the Final Office Action.

Claims Rejections – 35 USC 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 3-7, 9-12 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste and Aoyama (5,688,192). Note the rejections set forth in the Final Office Action. Further, Aoyama discloses that it is well known in the art of sportsballs to utilize resilient microspheres within the construction of the ball to alter the rebound characteristics.

Delacoste suggests altering or modifying the rebound characteristics of his ball by substituting the hollow or solid glass micro-balls with hollow microballs of very low density

(column 3, line 45 through column 4, line 13). Thus, it would have been obvious to one of ordinary skill in the art to replace the glass microballs taught by Delacoste with those taught by Aoyama in order to alter the rebound characteristics of the ball.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/09034 (Mills) in view of Delacoste, Aoyama and Kennedy et al. (5,091,265). Note the rejections set forth in the Final Office Action.

6. Claims 9, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (5,688,192). Note the rejections set forth in the Final Office Action.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (5,688,192) in view of Kennedy et al. (5,091,265). Note the rejections set forth in the Final Office Action.

Response to Arguments

8. Applicant's arguments filed November 14, 2003 have been fully considered but are not deemed to place the application in condition for allowance. Regarding the rejection over Aoyama, the rejection has been restated under 35 U.S.C. 102(e) because the priority date of the application predates the patent date of Aoyama. However, a rejection under 35 U.S.C. 102 has been maintained because the instant claims fail to read over the teachings of Aoyama. The applicant contends that Aoyama lacks the teaching for an outer skin having a first layer that includes a syntactic material. The applicant appears to be interpreting "outer skin" as necessitating that the layer be outermost on the ball. However, "skin" merely necessitates a layer for the ball and "outer" merely necessitates that the layer is farther out or away from the center.

The layer (5) qualifies as an “outer skin” as it is taught as being a layer and it is placed outward from the center of the ball.

Regarding the combination of Mills in view of Delacoste, the applicant contends that the combination lacks the teaching for “resilient” microballs. The rejection now includes the reference to Aoyama which teaches the use of resilient microballs in a sportsball environment. It is considered to have been obvious to one of ordinary skill in the art to replace the glass microballs of Delacoste with those taught by Aoyama in order to alter the rebound characteristics of the ball. Delacoste provides a suggestion for replacing the microballs by stating that the glass microballs may be replaced with hollow microballs of very low density in order to alter the rebound characteristics of the ball.

Regarding the rejection of claim 5, the applicant contends that the Aoyama specifically discloses that “glass microspheres would not be appropriate . . . because of their rigidity” (column 4, lines 3-5). While this is true, the combination is to replace the glass microballs of Delacoste with the resilient microballs of Aoyama. The applicant’s argument is directed to the reverse situation which is not being applied here.

The reference to Kennedy is relied upon merely for its teaching that aliphatic materials are well known in the art of sportsballs and to include one in the sportsballs of Mills, Delacoste or Aoyama would have been obvious to one of ordinary skill in the art.

Regarding the rejection of claims 9, 26 and 27, attention is directed to the comments on the rejection over Aoyama stated *supra*. Again, the instant claims fail to limit the outer skin to an outermost layer of the ball and thus, the layer (5) of Aoyama anticipates the claimed structure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Wong
Primary Examiner
Art Unit 3711

SBW
July 2, 2004